

Remarks

This Application has been carefully reviewed in light of the Office Action mailed July 5, 2007. Applicant believes all claims are allowable over the Examiner's rejections without amendment and respectfully provides the following remarks. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. Claim 13 Recites Patentable Subject Matter

The Examiner rejects Claim 13 under 35 U.S.C. § 101 as being directed to non-patentable subject matter. In particular, the Examiner rejects Claim 13 "because 'A system for generating an audio alert and processing an audio command' does not include any functional structure of a system (i.e. apparatus) An apparatus without any functional structure can be considered a program per se, which is not one of the categories of statutory subject matter." (Office Action at 2-3) Applicant respectfully disagrees.

First, Applicant respectfully submits that the Examiner has not cited any authority for the proposition that "[a]n apparatus without any functional structure can be considered a program per se."

Second, to the extent that Claim 13 is directed to or includes a program, Applicant respectfully submits that the Examiner cites no authority for the proposition that claims directed to software are not "one of the categories of statutory subject matter." (Office Action at 2-3) The United States Court of Appeals for the Federal Circuit has recently stated that 35 U.S.C. § 101 "explains that an invention includes 'any new and useful process, machine, manufacture or composition of matter.' Without question, software code alone qualifies as an invention eligible for patenting under these categories, at least as processes." *Eolas Technologies, Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338-39 (Fed. Cir. 2005) (citations omitted) (emphasis added). While Applicant's Claim 13 is directed to a system, to the extent that Claims 13 is directed to software, Applicant respectfully submits that it is statutory.

For at least these reasons, Applicant respectfully submits that Claim 13 is directed to patentable subject matter and requests reconsideration and allowance of Claim 13.

II. The Claims are Allowable over the Cited Combinations of References

A. Independent Claims 1, 13, and 15 and Their Dependent Claims are Allowable over the Proposed *Ward-Lewis-Lohmann* Combination

The Examiner rejects Claims 1, 4, 13, 15, and 20 under 35 U.S.C. § 103(a) as being unpatentable over a proposed combination of U.S. Patent 5,367,670 to Ward et al. ("*Ward*"), U.S. Patent 6,603,396 to Lewis, et al. ("*Lewis*"), and U.S. Patent 5,745,692 to Lohmann II et al. ("*Lohmann*"). Applicant respectfully traverses these rejections and discusses independent Claim 1 as an example.

1. The Proposed *Ward-Lewis-Lohmann* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 1

"To establish *prima facie* obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art." M.P.E.P. § 2143.03 (emphasis added); *see also In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. 2143.03 (emphasis added); *see also In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

At a minimum, it does not appear that the cited portions of the proposed *Ward-Lewis-Lohmann* combination disclose, teach, or suggest the following limitations recited in Claim 1:

filtering the [detected] alert condition [identifying a problem with a system component] to determine a notification path associated with the alert condition, the notification path being determined based at least on a property of an object associated with the alert condition, the object being stored in an object repository; and
outputting the audio notification message via the notification path.

For example, the cited portion of the proposed *Ward-Lewis-Lohmann* combination does not disclose, teach, or suggest "filtering the alert condition to determine a notification path associated with the alert condition, the notification path being determined based at least

on a property of an object associated with the alert condition,” as recited in Claim 1. As allegedly disclosing “determin[ing] a notification path associated with the alert condition, the notification path being determined based at least on a property of an object associated with the alert condition,” the Examiner relies on *Ward*, citing Col. 5, ll. 21-27. (Office Action at 3) The cited portion of *Ward* discloses the following:

As may be seen in FIG. 2, the path by which data accumulated during the monitoring of system components and parameters indicative of an actual or potential failure may be any one of four paths, depending on the particular type of actual or potential failure being monitored. Each system component being monitored may be referred to as an object having a number of attributes.

(*Ward*, Col. 5, ll. 21-27)

However, nowhere does this cited portion disclose, teach, or suggest any determination of a notification path associated with an alert condition, let alone “filtering the alert condition to determine a notification path associated with the alert condition, the notification path being determined based at least on a property of an object associated with the alert condition,” as recited in Claim 1. Instead, the mention of “paths” in the cited portion of *Ward* relates to “the path by which data accumulated during the monitoring of system components and parameters indicative of an actual or potential failure may be any one of four paths, depending on the particular type of actual or potential failure being monitored.” The path disclosed in *Ward* does not relate to any “notification path,” as recited in Claim 1.

Additionally, it does not appear that the cited portions of either *Ward* or *Lewis* disclose, teach, or suggest “filtering the alert condition to determine a notification path associated with the alert condition, *the notification path being determined based at least on a property of an object associated with the alert condition*,” as recited in Claim 1.

As another example, at least because the proposed *Ward-Lewis-Lohmann* combination fails to disclose, teach, or suggest “filtering the [detected] alert condition [identifying a problem with a system component] to determine a notification path associated with the alert condition, the notification path being determined based at least on a property of an object

associated with the alert condition, the object being stored in an object repository,” as recited in Claim 1, the proposed combination necessarily fails to disclose, teach, or suggest “outputting the audio notification message *via the notification path*,” as recited in Claim 1.

For at least these reasons, the proposed *Ward-Lewis-Lohmann* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 1. For at least certain analogous reasons, the proposed *Ward-Lewis-Lohmann* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claims 13 and 15. Independent Claims 1, 13, and 15 and their dependent claims are allowable for at least this reason.

2. The Proposed *Ward-Lewis-Lohmann* Combination is Improper

Applicant respectfully submits that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine *Ward*, *Lewis*, and *Lohmann* in the manner the Examiner proposes. Applicant's claims are allowable for at least this additional reason.

With respect to the proposed combination of *Lewis* with *Ward*, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*'s teaching would allow *Ward*'s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(Office Action at 4)

It appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's

invention (*without using Applicant's claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining. For example, even assuming for the sake of argument only that *Lewis* discloses "filtering an alert condition to determine a notification path associated with the alert condition," as argued by the Examiner, it is entirely unclear why the alleged motivation of "maximizing performance and reliability of the system" would lead one of ordinary skill in the art at the time of Applicant's invention to incorporate the teaching of "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of "maximizing performance and reliability of the system" would even be achieved by modifying the system of *Ward* to include "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly taught by *Lewis*.

There is certainly no reason to assume that one of ordinary skill in the art at the time of Applicant's invention would have been motivated to combine *Lewis* with *Ward* in the manner the Examiner proposes. Therefore, it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, combine *Lewis* with *Ward* in the manner proposed by the Examiner.¹ Respectfully, the

¹ If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicant respectfully requests that the Examiner provide a reference pursuant to M.P.E.P. §

Examiner's attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Applicant's claims, using Applicant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the Examiner has not demonstrated the required teaching, suggestion, or motivation to combine *Ward* and *Lewis* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

Applicant raised portions of this argument in the previous Response; however, the Examiner did not respond to this argument. According to the M.P.E.P., "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and ***answer the substance of it.***" M.P.E.P. ch. 707.07 (f) (emphasis added). Applicant recognizes that the Examiner is undoubtedly responsible for the examination of a large number of applications, placing inordinate constraints on the Examiner's time; however, Applicant submits that he should not be penalized for this fact and is still entitled to an examination of this Application in compliance with all applicable rules and guidelines. Applicant respectfully requests that the Examiner address this argument in the next Office Action if the Examiner does not change or withdraw the rejection or, more appropriately, issue a Notice of Allowance. Moreover, since the Examiner did not answer the substance of Applicant's argument with respect to the propriety of the *Ward-Lewis* combination, Applicant respectfully submits that it would be improper for the Examiner to make the next Office Action (should one be issued) final.

2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicant respectfully requests that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

For at least these reasons, Applicant respectfully submits that the proposed *Ward-Lewis-Lohmann* combination is improper. Independent Claims 1, 13, and 15 and their dependent claims are allowable for at least this additional reason.

3. Conclusions with Respect to Claims 1, 13, and 15

For at least these reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Ward-Lewis-Lohmann* combination with respect to independent Claim 1. For at least certain analogous reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Ward-Lewis-Lohmann* combination with respect to independent Claims 13 and 15. Thus, for at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 1, 13, and 15 and their dependent claims.

B. The Separately-Rejected Dependent Claims are Allowable

The Examiner rejects Claims 9, 17, and 21-22 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Lohmann* in view of U.S. Patent 6,021,262 to Cote, et al. (“Cote”). The Examiner rejects Claims 5-6 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Lohmann* in view of U.S. Patent 4,881,197 to Fischer (“Fischer”). The Examiner rejects Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Lohmann* in view of U.S. Patent 6,037,099 to Sabourin, et al. (“Sabourin”). The Examiner rejects Claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Lohmann* in view of U.S. Patent 6,421,707 to Miller, et al. (“Miller”). The Examiner rejects Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Lohmann* in view of U.S. Patent 6,161,082 to Goldberg, et al. (“Goldberg”). The Examiner rejects Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, Lohmann, and Fischer* in view of “Official Notice.” The Examiner rejects Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Lohmann* in view of U.S. Patent Publication No. 2001/0044840 filed by Carleton (“Carleton”). The Examiner rejects Claims 18-19 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, Lohmann, and Cote*

in view of U.S. Patent Publication No. 2004/0210469 filed by Jones, et al. ("*Jones*"). The Examiner rejects Claim 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, Lohmann, and Cote* in view of U.S. Patent 6,185,613 to Lawson, et al. ("*Lawson*").

Claims 3, 5, 7-8, 10-11, 18-19, and 23-24 depend from independent Claim 1, which Applicant has shown above to be allowable over the proposed *Ward-Lewis-Cote* combination, and are allowable for at least this reason. In addition, Claims 3, 5, 7-8, 10-11, 18-19, and 23-24 recite further patentable distinctions over the various proposed combinations of references.

For example, the cited portions of the proposed *Ward-Lewis-Lohmann-Cote-Jones* combination (which the Examiner applies against Claim 19) do not appear to disclose, teach, or suggest at least the following limitations recited in Claim 19:

- the notification path comprises a multi-tiered notification path, each tier of the multi-tiered notification path identifying one or more users assigned a level of responsibility with respect to the alert condition; and
- the method further comprises assigning the level of responsibility to each of the one or more users based upon a type of object associated with the alert condition.

Indeed, the Examiner does not appear to address the limitation "the method further comprises assigning the level of responsibility to each of the one or more users *based upon a type of object associated with the alert condition*," as recited in Claim 19. (See Office Action at 13-14)

Applicant reiterates that "[t]o establish *prima facie* obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art." M.P.E.P. § 2143.03 (emphasis added). "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. 2143.03 (emphasis added). It does not appear to Applicant that the cited portions of the proposed *Ward-Lewis-Lohmann-Cote-Jones* discloses, teaches, or suggests, at a minimum, "assigning the level of responsibility to

each of the one or more users based upon a type of object associated with the alert condition,” as recited in Claim 19.

To avoid burdening the record and in view of the clear allowability of independent Claim 1, Applicant does not specifically discuss in this Response the distinctions recited in other dependent claims. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicant does not admit that the various combinations of references proposed by the Examiner are possible or that the Examiner has demonstrated the requisite teaching, suggestion, or motivation in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to combine or modify the various references in the manner proposed by the Examiner.

The Examiner takes Official Notice of particular limitations recited in Claim 7 and asserts that such elements are well-known. Applicant respectfully traverses this Official Notice and disagrees with the Office Action regarding the alleged notoriety of these limitations. If the Examiner intends to continue to rely on the Official Notice in rejecting any claims, Applicants respectfully request the Examiner to cite a reference or provide a signed affidavit in support of Examiner's position in compliance with MPEP § 2144.03.

For at least these reasons, Applicant respectfully requests reconsideration and an allowance of dependent Claims 3, 5-11, 17-19, and 21-24.

III. No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the reference cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to

the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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